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Supreme Court of the United States

October Term, 1920

BERLIN MILLS COMPANY,

Petitioner,

versus

THE PROCTER & GAMBLE COMPANY,

Respondent.

Supplemental Brief for Respondent in Reply to Brief of *Amicus Curiae.*

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Supplemental Brief for Respondent in Reply to Brief of Amicus Curiae.

Since the *amicus curiae* brief was not received until after respondent's main brief had gone to press, we are obliged to submit this supplement in reply thereto.

The brief for the *amicus curiae* is in error in its initial proposition, in stating as a foundation for its entire argument that the question involved is one "which requires no analysis of the record to make clear, but is distinctly raised by the facts as they are conceded by the majority opinion of the Court of Appeals."

The brief bases its case on the following false premises which it assumes are established by the opinions of the Court. These false premises are:

(1) That the product of the patent as a product was the same as the prior art lard compounds of oleo or animal stearin and cottonseed oil;

(2) That the only difference between the patented product and the prior art compounds is in the process by which they are made;

(3) That the defendant's product is more like the prior art compounds than it is like the patented product;

(4) That defendant's product is made by a very different process from that employed in making the patented product.

The brief contends that only a legal question is involved, which it asserts to be, whether a product patent can be sustained as valid because made by a novel process or a defendant's product similiar to the prior art, made by a different process, be held an infringement.

If these premises were sound, the argument of the *amicus curiae* brief would be quite persuasive.

We have not the slightest desire to combat the legal proposition that a patent for a product, if the product is old, cannot be sustained because of novelty of process, nor a defendant's product like the prior art made by a different process held an infringement.

The complete answer to the argument of the *amicus curiae* as it is to the argument of the petitioner, is that the patented product is not old; that it was not conceded to be old but found radically new, by the Court of Appeals, and that its novelty is fully and completely established by the record.

We have fully considered these questions of fact in our main brief already filed which may be taken as a reply to the *amicus curiae* brief as well as to the brief of Petitioner; but it would seem proper to again summarize our position in direct reply to the brief for the *amicus curiae*.

In our brief in reply to petitioner, we show that the

product is new, as a product and that defendant's Kream Krisp infringed the novelty of the product. We show that the incompletely hydrogenated product of the claims contains a relationship between its liquid constituents, linolin and olein, which no compound ever before possessed and that Kream Krisp infringed this relationship. We, therefore, maintain that Burchenal's product exhibits a radically new principle as a product (set forth at page 6 *et seq.* of our main brief), which new principle is infringed by Kream Krisp, and that this new principle has proven itself of great value to the public and is well worthy of patent protection.

We also show that the prior art compounds were part animal and part vegetable since they were composed of animal or oleo stearin mixed with cottonseed oil. The compounds like Jewell were not in the prior art but were the subject of Burchenal's companion patent, the application for which was co-pending with that of the patent in suit which patent therefore is not a part of the prior art.

Toledo v. *Kawneer*, C. C. A., 237 Fed., 367.

> "Nor was Plyms first patent prior art as related to the second patent; the later patent having been applied for by the same inventor before the first patent issued."

See also

> *Century Co.* v. *Westinghouse*, C. C. A., 191 F., 352.

Either of the foregoing features is sufficient to distinguish Kream Krisp and the patented product from the prior art compounds,—either (1) the difference in

relationship between linolin and olein or (2), the difference between an all vegetable product and a part animal product. While we direct our discussion principally to the first distinction we do not wish the second to be overlooked.

Even the production figures given on page 2 of the *amicus curiae* brief, go only to show the importance of the Burchenal invention in enlarging the field of artificial lard, by presenting the world with a new product which it never had before and would not have had now but for his invention, and which has enormously increased the food resources, as shown by its sales (see our main brief, pp. 37 to 39).

The product of the patent was not old, but embodied a radically and entirely new principle. In no compound of the prior art was the relative proportion of linolin to olein different than in cottonseed oil. No compound of the prior art contained a higher percentage of olein or a lower percentage of linolin relatively to each other than cottonseed oil.

This was inevitably so, because when, in the compounds, oleo or animal stearin was mixed with cottonseed oil, only the proportion of stearin to the other ingredients was increased. The percentage of the other ingredients relatively to each other was obviously unchanged. Therefore the product could not possibly have been the same as that of the patent or of defendant, in which the percentage of linolin and olein to each other is changed; the linolin being reduced and the olein relatively increased, so that compared with cottonseed oil, as the patent says, the product contains "a high percentage of olein, a low percentage of linolin and the lesser saturated fats." That the patent makes this

statement in a comparative sense, compared with cottonseed oil appears from its context in the patent. This statement is a summary of the comparison with cottonseed oil given in the sentence immediately preceding. This comparison not merely follows of necessity from the constitution of the two products, but it is testified to on both sides.

In the first place, this appears from defendant's analysis of the product compared with its analysis of cottonseed oil, showing that the linolin has been decreased and the olein increased so as to have comparatively "a high percentage of olein, a low percentage of linolin," as stated in the Burchenal patent. We take the following figures, showing the above, from defendant's own analysis omitting decimals (R., p. 358, QQ. 14 and 18):

	Cottonseed Oil	Kream Krisp
Linolin	46	37
Olein	32	34

In the next place, this appears by the unwilling admission of defendant's expert, Dr. Walker (page 336):

> "XQ. 176. * * * It is true is it not that defendant's Kream Krisp is lower in percentage of linolin than the cottonseed oil from which it is produced? And higher in percentage of olein?
>
> "A. Referring to Chart 401, it is seen that the linolin is less than in the cottonseed oil. The olein is slightly, though very slightly, greater."

In the next place, it appears from the testimony as to the process, that the inevitable result of partial hydro-

genation is to change the relative proportions of linolin and olein. Dr. Walker was forced to admit this also (page 337:

> "XQ. 187. How high and how low in olein have you seen analysis of Kream Krisp?
>
> "A. The olein would not, of course, be lower than the olein of the oil, because the linolin is so much more easily attacked than the olein that the tendency is to build olein up rather than drag it down."

This is confirmed by the testimony of Morrison, called by defendant (page 197):

> "Q. 28. That is to say, it was your observation that the linolin was first changed to, say, olein, without a corresponding change of olein to stearin?
>
> "A. That is correct, sir.
>
> "Q. 29. So that in the final product you would have a fairly large proportion of olein and a small proportion of linolin.
>
> A. That is correct, sir.
>
> "Q. 30. In other words, you determined that there is a certain selective action that takes place during the hydrogenation.
>
> "A. Yes.
>
> "Q. 31. And the speed of reaction of linolin to olein is very much greater than that of olein to stearin, under the particular conditions of hydrogenation that were then practiced.
>
> "A. Well we tried quite a number of conditions but found that to be the same in each case."

In the next place, the same thing is shown by the following excerpt from the table in Petitioner's brief (page 61):

	Cottonseed Oil	Petitioner's Product
Per cent. Olein	32.5	34.3
Per cent. Linolin	46	37.7

showing that the operation of petitioner's process is to raise the olein from 32.5 to 34.3, and to lower the linolin from 46 to 37.7.

In view of these admissions by defendant's analyses, defendant's witnesses, and defendant's brief, how can it be contended that defendant's product is the same as the prior art compounds, in which the relative proportions of linolin to olein was the same as it was in cottonseed oil, because, obviously, the mere addition of stearin to the cottonseed oil did not change the relationship to each other of the olein and linolin therein.

The beneficial effect of raising the olein and lowering the linolin in the product, exhibited by the corresponding decrease in the tendency to rancidity or oxidation producing rancidity, is also admitted by Dr. Walker (p. 335):

> "XQ. 172. You think that probably there is more oxygen taken up by linolin, then, than by either olein or stearin?
>
> "A. I would expect that to be the case."

Dr. Bacon admits (Rec. p. 444 XQ. 22) "Linolin oxidizes much more easily than olein."

This is fully confirmed by defendant's circulars, which contain such statements as follows:

> "You can keep a tin of Kream Krisp open to the air in a warm room indefinitely. There is nothing in it to turn rancid." (page 507).
>
> "Kream Krisp contains nothing which oxidizes readily." (Rec. p. 508).

"But, although Kream Krisp is a pure vegetable oil product the hydrogen which changes it into its semi-solid (butter-like) form, renders it immune to chemical change." (Rec. p. 512).

"Butter, lard and lard compounds turn rancid because they absorb oxygen, but Kream Krisp resists oxidation better than any other shortening in use." (Rec. p. 515).

The testimony of defendant's expert Dr. Bacon does not fully contradict the above statements of defendants' catalogue that Kream Krisp differs from the compounds in containing less rancid producing material (linolin) than the compounds. On the contrary Dr. Bacon admits (Rec. p. 449) that Kream Krisp is lower in linolin (37 to 38 per cent.) than the compounds (41 to 42 per cent.); saying (Q. 336) "In Kream Krisp there is 37 to 38 per cent. linolin and in lard compounds 41 to 42." This is because in Kream Krisp as in Crisco the cotton seed oil has been chemically changed whereas in the compounds it has not. As the result of this Dr. Bacon ranks Kream Krisp as less rancidable than the compounds and next to Crisco; saying (Q. 364) "I will give them in the order in which they resist rancidity—are, first Armour's Simon Pure Lard; second Crisco; third Kream Krisp; fourth, lard compounds prepared from 80 per cent. cottonseed oil and 20 per cent. oleostearin; and, fifth lard compounds (which we deny were prior art), prepared from 90 per cent. cottonseed oil and 10 per cent hardened cottonseed oil."

It is because neither Crisco nor Kream Krisp contains any unchanged cottonseed oil and because the change has made both of them comparatively low in linolin and high in olein that Dr. Bacon has been com-

pelled to rank them higher than the compounds in resistance to rancidity. The reason that they do not rank exactly the same is because Kream Krisp, while following the principle of the patent, does not follow it as far as Crisco, but under all the authorities this does not avoid infringement.

Sewall v. *Jones*, 91 U. S., 171, 173.

Cawood Patent Case, 94 U. S., 695, and other cases cited in our main brief, pp. 74-76.

The statements of defendant's circulars as to Kream Krisp are substantially a repetition of the statement of the patent (page 1, line 28):

> "All such vegetable oils contain glycerides of unsaturated fatty acids and among them notable quantities of fatty glycerides of lower saturation than olein. It is the presence of these glycerides of lower saturation that seriously affects rancidity of the material. Oxidation is largely the cause of rancidity, which oxidation weakens the fat at the point of absorption at the double bonds and these glycerides of lesser saturation readily absorb oxygen from the air at ordinary temperatures while the more highly saturated glycerides, such as olein, only absorb oxygen at elevated temperatures."

Thus, in the manufactures of Kream Krisp, as in that of the patented product, it is the lowering of the linolin relatively to the olein which had never existed in any compound of the prior art and which tends to give immunity from oxidation or rancidity, and the immunity from oxidation or rancidity is in proportion as the linolin is lowered and the olein is raised. According to defendant's own analysis, in the manufacture of Kream

Krisp the linolin is lowered about 9 per cent. and the olein raised about 2 per cent. To that extent it involves the principle of the patent in suit, and to that extent it is more immune from oxidation or rancidity than is the cottonseed oil from which it is produced, or from any compound containing such cottonseed oil.

The *amicus curiae* brief (page 4) quotes from Judge A. N. Hand's opinion where he introduces a parallel between the Burchenal product and Kream Krisp, from which he concludes:

> "Thus it appears that Kream Krisp instead of being low in linolin is extremely high, etc."

This parallel is not the true criterion, because Burchenal undoubtedly carried the principle of the patent further than Kream Krisp. But it is an elementary principle of patent law that one does not escape infringement because he does not carry the principle of the patent to the extent of the patentee. The true parallel is between Kream Krisp and cottonseed oil, which we have already given above from defendant's own analysis and which shows that compared with cottonseed oil, Kream Krisp is about 9 per cent. lower in linolin and about 2 per cent. higher in olein. To this extent, therefore, it is clearly an infringement.

The same comparison shows that the following statement of Judge Hand quoted by the *amicus curiae* brief (page 5) is erroneous:

> "Indeed the composition is much closer to the lard compound Jewel made out of stearin and cottonseed oil than to Crisco."

The relative proportion of linolin to olein in Jewel is the same as in the cottonseed oil to which the stearin

is added in its formation. It, therefore, does not embody the principle of the patent in suit, as does Kream Krisp, and does not embody the changed relative proportions of linolin to olein, which is the novel characteristic common to both Kream Krisp and the product of the patent.

From the table of percentages given on page 48 of Petitioner's brief, and repeated on page 13 of the *amicus curiae*, a parallel may be made between the linolin and olein, respectively, in Jewel and in Kream Krisp, as follows:

	Jewel	Kream Krisp
Per cent. Linolin	41.5	37.7
Per cent. Olein	29	34.4

From this it can be seen that compared with Jewel, the Kream Krisp is low in linolin and high in olein, and that it, therefore, embodies the principle of the patent in suit, while the Jewel does not.

The same thing is shown by the diagram opposite page 68 of Petitioner's brief, to which the *amicus curiae* brief twice refers. A study of this diagram will show that the olein in "Defendant's Artificial Lard" is 34.3 per cent. as against 29 per cent. in "Prior Art Artificial Lard," while the linolin is only 37.7 per cent. as against 41.5 per cent. This shows again that as compared with the prior art compounds, Kream Krisp is "high in olein, low in linolin," as it must be, because the compounds contain cottonseed oil and Kream Krisp does not.

Thus it appears that defendant's own figures when properly compared show the incorrectness of the statement on page 13 of the *amicus curiae* brief, that, "if

the claims of the patent reach the defendant's product s product, they are anticipated by the prior art products as products."

It should be remarked, however, that the Jewel compound does not represent anything in the prior art, because the only compounds in the prior art were made by mixing animal stearin with cottonseed oil; while Jewel is made by mixing hydrogenated cottonseed oil with unhydrogenated cottonseed oil, which is a subject of the companion patent of Burchenal to the patent in suit, and is not prior art, as we have explained in our main brief.

If it were true, as the *amicus curiae* brief repeatedly asserts, that neither the process nor the product was new, that would be a quick end of the matter; but, on the contrary, both the process and the product were new. We have already shown that, as products, none of the prior art compounds were free from cottonseed oil, as are Kream Krisp and the product of the patent, or, in other words, free from the relative proportions of linolin and olein.

Coming to the process, while it is true that the process of hydrogenation was old, nevertheless Burchenal was the first to stop the process before completion and thus to develop a new process of half-done treatment and to utilize the half-done or incompletely hydrogenized product. There are two processes involved in describing how the new product is made, one the old process by which the oil was caused to absorb hydrogen; the other, the stopping of the treatment at a certain point. This stop treatment was new and was utilized by the defendant, because as we have shown in our main brief (pp. 53-4) by the admissions of defendant's expert,

defendant's process is carefully regulated so as to prevent the melting point of the product rising above about 42 degrees Centigrade: that being about the melting point at which the process described in the patent arrests the hydrogenation. Therefore, in the respect that the process of the patent was novel, defendant's process follows it.

The *amicus curia* brief (page 6) repeats the statement of the Court below, that the defendant's process of manufacture was "very different from that of plaintiff."

The Court here is evidently referring to the method of bringing about the absorption of hydrogen by the oil and not to the process of arresting the treatment at a certain point. So far as the principle of this invention is concerned, the processes are alike, in that they both stop the hydrogenation before it is complete and they both change the relative proportion of olein to linolin by reducing the linolin and increasing the olein in the product, as compared with the cottonseed oil treated, and thereby decrease the liability of oxidation or rancidity.

The *amicus curiae* brief is entirely erroneous in its statement as to Kream Krisp (page 10), that:

> "The fact that a portion of the oil has been hydrogenized to a solid fat does not alter the fact that the product itself is a mixture of the original oil with that portion which has become solid fat. * * * It consists of a mixture of cottonseed oil and hard fat."

On the contrary, no part of it is the same as cottonseed oil because the relationship between its liquid constituents (linolin and olein) has undergone change, as

well as the relationship between its liquid and hard ingredients, the percentage of linolin being low and of olein high compared with cottonseed oil, as we have repeatedly shown.

Upon the above erroneous assumption, the *amicus curiae* brief argues (page 10) that Kream Krisp is not homogeneous in the sense of being mixtureless. It certainly is not a mixture of cottonseed oil, because there is no cottonseed oil in it. The defendant's circulars were absolutely correct in contradicting the *amicus curiae* brief by such statements as the following:

> "Kream Krisp, although made exclusively from highly refined vegetable oil, *contains no oil itself.* The oil is *completely changed by hydrogenation.*" (R. pp. 509 and 516).

Such statements were made in defendant's circulars in distinguishing Kream Krisp from the very "compounds" or mixtures which the *amicus curiae* brief now alleges to be the same thing. These statements of defendant's circulars are true, because Kream Krisp contains no cottonseed oil. The oil throughout has been chemically changed and the proportion of linolin lowered, while that of olein raised. These statements of defendant's circulars correspond with the patent in suit, which, in pointing out that the product contains no cottonseed oil, adds, "thereby differing from all commercial lard substitutes containing this oil." Defendant's circulars say, "for this reason Kream Krisp has been called "one of the most notable discoveries in pure food chemistry of the present day."

The argument of the *amicus curiae* brief (page 11) that Kream Krisp is not "lard-like," is impeached by an inspection of the product, as well as by the fact that

defendant sells it because it is lard-like, and so represents it in its circulars and labels.

Moreover, defendant's expert, Dr. Walker, was forced to admit this. (Rec. p. 320).

> "Q. 54. Have they been used in your household, Crisco and Kream Krisp?
>
> "A. I have used Kream Krisp more especially from our interest in it; I don't know whether we have ever used Crisco or not.
>
> * * * * * *
>
> "Q. 57. So you cannot say whether that practically answers the same purpose in general?
>
> "A. Not from my own experience, no; but I think there is no doubt but that they do."

The *amicus curiae* brief (page 13) asks the question:

> "What is there which would bring the defendant's product within the range of the claims of the patent in suit and exclude the prior art products?"

We answer: The fact that it is incompletely hydrogenized and, therefore, contains the liquid ingredients linolin and olein in a different relationship or relative percentage from that theretofore existing; the linolin being high and the olein low compared with cottonseed oil or the prior-art compounds thereof, wherefore the liability to oxidation productive of rancidity is decreased.

So much for the facts as established by the record as to the novelty of the patented product as a product, and the irrelevancy of the question of law as presented in the *amicus curiae* brief.

The assumption that there was any concession in the opinions of the Court of Appeals that the product was old

or any confusion between novelty of process and novelty of product in those opinions is equally unfounded.

As we have pointed out in our main brief (pp. 48-51), the Court of Appeals at the outset, and when taking up the question of patentability and validity, treat the patent clearly as a product patent.

The Court points out that the patent described "a visible, tangible thing, that no one had ever made it before and that as a new thing there was no closely related prior art" (Rec., p. 774). The decision then takes up the three objections of the defense which were (a) that the patent did not rise to the dignity of invention. (b) that no one could have a valid patent the result of stopping an old process for making an old product when half done, (c) that the prior art disclosed the same thing but made in a different way and that a valid patent could not issue for an old product because the process was new.

In answer to objection (a) the Court said it was sufficient to say that no one in a score of years had produced the product, which was desirable, useful and apt for commercial success and that this was certainly persuasive of some invention.

In answer to objection (b) the Court held that it did involve invention to discover a use for something which might be termed a half product or unfinished product of an existing method of procedure, if the product was a different thing from that which existed before the process began and that which would exist when it ended.

In answer to (c) this objection was disposed of on the same grounds upon which objection (b) was overruled. "For substantially the same reasons we think there is nothing at all in the last (c) objection. (Rec. p.—):

> "The chemical composition of steam, water and ice is the same but they are different things and in the same common sense way oil, lard and stearin are different things, although (with some chemical latitude) the oil may be said ultimately to become stearin and to pass through the lard stage on the way." (Rec., p. —.)

The Court then went on to say that so far as the cook was concerned the prior art products (lard compounds) might be used for the same cooking purposes as the new chemically changed cottonseed oil and so far as the chemist was concerned the same chemical elements might be found in the new Burchenal product as in the prior art compounds, yet the fact that the old and new products were different products was the controlling factor which made a vital difference in the eye of the law. Could the court have more clearly demonstrated than they did that in comparing the old with the new, they had clearly in mind that they were comparing product with product and in no way confusing product with process or determining novelty of product by the test of process by which it was made? There is no concession on the part of the Court of Appeals that the patented product and all prior art products were the same except made by different processes. On the contrary, the court repeatedly says that the products were different things. That the court was right in this finding we have clearly demonstrated.

But argues the *amicus curiae*, while the Court of Appeals says the products were different, what they really had in mind was that the old and new were only distinguishable by process of manufacture. One was a mixture and the other was not. It is argued from this that the court meant one was made by the process of

mixing and the other was made some other way. In other words, process was in mind and not product. There is no basis for this conclusion. What the court had clearly in mind was that one was cottonseed oil rendered semi-solid by the addition of stearin, while the other was not cottonseed oil at all, but a chemically changed cottonseed oil.

If the cottonseed oil rendered semi-solid by the addition of stearin or stearin made semi-solid by the addition of cottonseed oil, was the same in its uses and properties, its qualities and characteristics as a chemically changed cottonseed oil, there might be some basis for contention that the two products were the same, but we have shown that the main object of the patent was to decrease the rancidable or readily oxidizable components of the lard substitute and that the Burchenal product did accomplish this result. It takes a certain proportion of liquid and solid fats to make a lard like semi-solid. There are two liquid and one solid fat in the composition; one of the liquids (linolin) is rancidable and readily decomposed or oxidized, the other liquid (olein) is stable and will not become rancid.

In all prior art products, whatever proportion of rancidable and stable liquids were found in the cottonseed oil remained the same in the lard substitute. In the Burchenal product, the sum of the liquids remained the same as in the prior art compounds but the proportions were changed, the linolin (rancidable) was reduced, the olein (stable) was increased. This change of proportions was not found in the prior art products. How can it be contended that the products are the same? Whether we characterize the one as mixtureless and the other as

mixed, or whether such designation is error and leads a captious critic to contend that such designation involves process, the fact is that the one product is essentially different from the other and possesses self-preserving qualities of very vital importance in a food product which are not found in the older product. This indeed is the crux of the whole matter and fully justifies the finding of validity in the Burchenal patent, and to the extent that defendant's product patterns after Burchenal that product infringes because it is in that quality or capacity of self preservation that defendant's product simulates the patent and departs from the prior art.

The *amicus curiae* is in error in including that because one lard substitute may be used by the cook for the same purposes that another lard substitute is used and that the chemist might put them in the same class, that therefore there is no difference between them. The composition of one which tends to keep it fresh and pure long after the other has become rancid is an extremely valuable quality. When both are fresh, the cook may know no difference. Quantitative and qualitative analysis may reveal the same number of atoms of carbon, hydrogen and oxygen in both products, but in one these elements are united so as to be more difficult of oxidation while in the other they are not so united. The two products are in very truth different in the proportions of their liquid glycerides. In one we employ a softening liquid for the hard stearin which is more stable than the other. It is not surprising that in the opinion on rehearing the Court of Appeals should have said "the patent in suit is almost basic instead of disclosing a mere variant among products of equal utility" and that "the results

(the products) of said evolutionary treatment are by their genesis so novel that analysis of constituents is immaterial."

Nor was the court disposed to allow the defendant to escape because its product did not contain so much of the stable and so little of the unstable liquid or softening fats with which its product was made as the Crisco product nt out by the plaintiff.

The defendant's machines did have the effect of changing the liquid components, so as to decrease the rancidable element, linolin, and vary the proportions of the liquid fats and the court was constrained to say "that defendant's machines will cease to produce infringements only when they yield what a plain man would not call lard," that is, what a plain man would not call the material used by the cook for the same purposes as lard.

The claims of the patent call for a new product "consisting of an incompletely hydrogenized vegetable oil or cottonseed oil."

A material "incompletely hydrogenized" can only mean that the material, the thing, has not taken up or absorbed all the hydrogen it could absorb. The phrase is proper as describing a product. It describes or specifies the ingredients, not the method of treatment. The claims do not call for an article produced by the process of "arrested hydrogenation" and the criticism of the *amicus curiae* brief of this phrase is beside the point.

As the Court of Appeals said in its rehearing opinion (Rec., p. —), the fact that "The principal producer of cottonseed oil has joined in this application as *amicus curiae* * * * has greatly magnified the importance of Burchenal's patent," this interest, however, did not jus-

tify the presentation of the statistics of the cottonseed oil industry found on page 2 of its brief; when the record shows that the plaintiff with its tremendous publicity advertising campaign has only been able to absorb five per cent. of the total production of refined cottonseed oil in a year.

The statistics of the oil industry are no more pertinent than it would be, if a new paint had been discovered and patented, to seek to magnify the importance of the issue in the event of s . by giving the number of billions of gallons of paint ..sed in any one year.

To sustain the Burchenal patent neither gives nor tends to give a monopoly in the cooking fat industry.

CONCLUSION.

The entire argument of the *amicus curiae* brief is founded on a false premise, apparently derived not from a study of the record, but from a consideration of the arguments in the brief of the petitioner based on the same false premise, and an effort to interpret the language of the Court of Appeals' opinions to fit the false premise.

The patent in suit is based on the principle that while both of the liquid fats of cottonseed oil will take up hydrogen, the more unstable, rancidable linolin is more susceptible to the absorption than is the stable olein, so that when the .nount of hydrogen to be absorbed is carefully regulated and controlled and the absorption stopped at the semi-solid state, a new homogeneous, lard like food product will result, more stable than and superior to any lard compound in which stearin has been added to the cottonseed oil.

This same product is put out by the defendant, which, while not as stable a product as the preferred product of the patent, involves the same new composition.

The decree of the Circuit Court of Appeals finding validity and infringement should be affirmed.

Respectfully submitted,

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CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1920.

No. 93.

ON WRIT OF CERTIORARI.

BERGER MFG. COMPANY,
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vs.

THE PRESSED STEEL CAR COMPANY,
Respondent.

RESPONDENT'S RESPONSE TO SUPPLEMENTAL BRIEF OF PETITIONER.

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Press of Byron S. Adams, Washington, D. C.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1920.

No. 93.

ON WRIT OF CERTIORARI.

BERLIN MILLS COMPANY,
Petitioner,

vs.

THE PROCTER & GAMBLE COMPANY,
Respondent.

RESPONDENT'S REJOINDER TO SUPPLEMENTAL BRIEF OF PETITIONER.

Both respondent's main and supplemental briefs were served and filed as early as October 18th, and therefore more than three weeks before the hearing and in full compliance with the Rule. Petitioner's supplemental brief was not served or filed until November 8th, only

two or three days in advance of the hearing and therefore as we understand it, in violation of the Rule.

Respondent begs to submit the following reply thereto which obviously it was, under the circumstances, unable to prepare earlier.

Petitioner's supplemental brief (commencing p. 1) is in error in criticising the statements in respondent's briefs. The positions taken in respondent's briefs are correct and true to the record. It is the petitioner's statements that are erroneous. The compounds, such as Flake White and Jewel, differ, as products, from Crisco and Kream Krisp in that the compounds contain cottonseed oil substantially unchanged; whereas there is no cottonseed oil in either Crisco or Kream Krisp, it having been converted by the partial hydrogenation into a body containing a different ratio between the linolin and olein from that which existed in cottonseed oil.

Even the figures given in petitioner's supplemental brief furnish proof of the correctness of respondent's briefs.

Throughout the case heretofore petitioner has uniformly treated the solid body added to cottonseed oil for producing the compounds as being substantially pure stearin. In its supplemental brief, however, petitioner assumes a different position and now contends (as we believe without proof) that the solid body added to the cottonseed oil for the production of the compounds contains a little olein in addition to the stearin. Even if we assume this to be true for the sake of the argument the statements of our briefs which have been criticized are substantially correct, because the olein contained in the solid body is so slight in amount as to be substantially negligible and not sufficient to take the liquid constituents of the compound out of the range of cottonseed oil. This,

as we have stated, appears from the figures of the petitioner's brief as follows:

At the top of page 4, petitioner's supplemental brief gives a table including the percentages of olein and linolin in cottonseed oil as given by the four experts in the case. Since we are concerned only at the present moment with the ratio of olein to linolin we may reproduce this table omitting the stearin as follows:

	Morrison	Walker	Baskerville	Richter
Per cent Olein....	29.6	32	28.9	32.5
Per cent Linolin..	48.6	46	47.8	46

From this table the following ratios of olein to linolin may be figured:

Morrison, .61
Walker, .69
Baskerville, .60
Richter, .706

It will thus be seen that for cottonseed oil the range in the ratio of olean to linolin runs from .60 to a little more than .70.

It is only necessary to turn to the figures given in petitioner's supplemental brief (p. 4, line 30, and p. 7, line 27) to find the corresponding percentages for Jewel and Flake White compounds:

	Jewel	*Flake White*
Per cent Olein.....	29	28
Per cent Linolin.....	41.5	42

The ratios of olein to linolin figured from these percentages are as follows:

Jewel, .699
Flake White, .667

This proves that the liquid constituents of the compounds are, as respondent has stated in its briefs, substantially the same as in cottonseed oil, because we have shown above that the range for the ratio of olein to linolin for cottonseed oil deducible from petitioner's supplemental brief was substantially from .60 to .70, and the ratios for Jewel (.699) and Flake White (.667) fall within this range.

The above figures are a sufficient reply to the five reasons given by petitioner (pp. 3 to 8) for saying that there is no truth in our allegation that the ratio of olein to linolin is the same in the prior art compounds as in cottonseed oil.

According to the proof in this record therefore, as expounded in petitioner's supplemental brief, no vegetable compound ever existed in the prior art wherein the relationship between the liquid constituents differed at all from that of cottonseed oil. This means that prior to the Burchenal invention no lard-like substance ever existed in which the liquid constituents were less rancidible than cottonseed oil.

Applying the same method of figuring to Kream Krisp and Crisco it is found that the liquid constituents thereof are both high in olein and low in linolin compared either with the whole range of cottonseed oil above given or with the liquid constituents of Flake White or Jewel.

This means of course that even on the figures given in petitioner's supplemental brief it is proved that, compared with the lard compounds, Kream Krisp and Crisco were not only new as products but both embody the fundamental principle set forth in the patent in suit and in our brief (p. 6) of reducing rancidibility by increasing the olein and decreasing the linolin in comparison with the prior art.

The proportions of the ingredients of cottonseed oil referred to by petitioner (lines 24 to 28, p. 4) as having been reported to Burchenal in 1910, Mr. Burchenal did not pretend to remember accurately but said (Q. 726, p. 65): "I don't recall them exactly." And question 727 referred to by petitioner asked him merely for an "approximation." Therefore we have referred above only to the witness who pretends to be accurate.

It is no answer to these positions for petitioner's supplemental brief to refer to lard as it does on page 8. No citation of any substance in whole or in part animal can impeach the novelty of our vegetable product. The differences between substances in whole or in part animal is so great, as products, that the U. S. Government requires inspection and stamps (34 Stat. L., 1260-5), while no inspection is required of the patented product because, as a product, it is vegetable. Both the claims in issue specify a vegetable product.

Cottonseed oil consists essentially of three components, or rather classes of components, which have been designated in this record under the names of stearin, olein and linolin. Stearin is the solid component, and olein and linolin the liquid components. Of these liquid components olein is relatively stable (as against tendency to become rancid) while linolin (in which term are included all bodies of lesser saturation than olein) is the rancidible component.

In order to prepare from cottonseed oil products of relatively high stability, it is necessary as was first shown by Burchenal to reduce the proportion of the rancidible components, here termed linolin. Burchenal did this by a partial hydrogenation, whereby a part of the existing linolin was transformed into olein. The effect of this treatment was obviously to increase the ratio of olein to

linolin. Under this treatment there was an actual removal or elimination of a part of the existing linolin (including the even more rancidible components) with the production of a corresponding quantity of the relatively stable and desirable olein.

The petitioner now contends that the oleo-stearin which was used to harden cottonseed oil contains in addition to stearin some small proportion of olein; and that it would necessarily follow from the addition of this material that the ratio of olein to linolin in the product would be disturbed in the same sense as if a part of the linolin were converted into olein.

It has been shown above that any such disturbance of the existing ratio of olein to linolin by the addition of oleo-stearin is so insignificant as to be negligible, as shown by the fact that the Jewel compound in this way still carries olein and linolin in a ratio which is within the range of cottonseed oil.

But even if this were not the case, and the proportion of olein introduced with the oleo-stearin were sufficient to increase materially the ratio of olein to stearin, the resulting product would still differ fundamentally from that produced by Burchenal by his partial hydrogenation method. The reason for this is that the oleo-stearin addition method does not involve the removal or elimination of any linolin, but *merely* the building up of the olein by adding more olein from an outside source. There is nothing in the record to indicate that such additions of olein, with or without stearin, would even tend toward the production of more stable products, as does admittedly the Burchenal process according to which the olein is built up at the expense of those rancidable compounds which are here classed as linolin.

The little, if any, olein which may have accompanied

the stearin from which compounds were made was not there for any purpose. In fact, it was rather detrimental to the purpose in view, which was solely to reduce the liquidity of the cottonseed oil. Obviously what was needed for this purpose was the solid and not a liquid and the presence of any liquid with the solid impaired its efficiency for the purpose intended. This little, if any, olein comes clearly within the category of things "accidentally and unwittingly" used "while the operators were in pursuit of other and different results" which this Court has held to be negligible as matter of law. (Tilghman v. Proctor, 102 U. S., 711; Carnegie Co. v. Cambria Co., 185 U. S., 423; Clough v. Barker, 106 U. S., 175.)

This little, if any, olein never carried with it any idea of the preservation fundamental principle of the patent in suit. For all the above reasons it was negligible both as matter of fact and of law.

Petitioner's seventh position (p. 8 to 12) is that respondent has changed its position from that taken in the court below. Such is by no means the case, as can be readily shown by quotation from the respondent's brief in the Circuit Court of Appeals.

The expression "mixtureless" was adopted as a convenient expression to indicate that the product, as a product, differed from the compounds because it contained no cottonseed oil, whereas the compounds are, as products made up substantially of cottonseed oil plus the added hardening substance. Without referring at all to the process of making, it is therefore correct to say that the compounds are mixtures and the product of the patent is not a mixture but is throughout a new product.

In plaintiff's brief in the Circuit Court of Appeals (p. 10), under the heading, "This is the first mixtureless cooking fat substitutable for lard," the following state-

ment of our position there corresponded exactly with our position here.

> "The inventor here produces by chemical action a new homogeneous, unitary or primary fat manufactured directly from vegetable oil and especially from cottonseed oil. By this chemical treatment he changes the chemical constitution of the cottonseed oil, so that it is no longer cottonseed oil; but it constitutes a new fat, which possesses the qualities and characteristics of lard without being made by mixing so that the new product is just as much a unitary unmixed thing as lard itself is.
>
> "By this chemical change, moreover, the substances in the oil which cause rancidity are very largely removed or rather they are chemically converted into more stable components so that a much more lasting and valuable product is obtained. This fact is of tremendous importance inasmuch as all mixtures contain from 85% to 90% of the original cottonseed oil, and this oil still retains the low grade material which readily becomes rancid even when mixed with the beef stearin or other hardening agent."

It will be seen therefore that as used before the Circuit Court of Appeals, the word "mixtureless" referred to the product and not to the process and signified that the product contained no cottonseed oil but consisted of liquid constituents differing from cottonseed oil in that it was more immune from rancidibility. That is exactly our position here. When the Circuit Court of Appeals came to decide the case it adopted our above position and in comparing the patented product with the prior art compounds, said:

"One is a mixture and the other is not" (R. 775); evidently meaning that one contains the original cotton-

seed oil substantially unchanged and the other does not.

Again referring to Kream Krisp, the Circuit Court of Appeals said (R. 778):

"What the defendant makes and sells is not only lard-like, homogeneous in the sense of mixtureless and wholly consisting of an incompletely hydrogenized cottonseed oil * * *."

Again adopting our position there, which is the same as our position here, the Circuit Court of Appeals said (R. 802):

> "Hydrogenized oil, as a substitute for lard is so superior to an amalgam, combination or mixture of oil and an animal fat or oil and stearin artificially produced—that the patent in suit is almost basic, instead of disclosing a mere variant among products or equal utility."

The position taken by respondent is fully supported by the commercial view taken of the several substances, it being testified to even by petitioner's witness Richardson (R. 352) that the compounds are regarded in a different class from Crisco.

It must also be remembered that respondent's position finds full support in the circulars of petitioner which petitioner's supplemental brief (pp. 24-25) is obliged to totally repudiate. The statements of these circulars to the effect that the compounds contain cottonseed oil, whilst Kream Krisp does not, are substantially true, and in accordance with the evidence as we have above demonstrated from the figures taken from petitioner's supplemental brief. The statements of these circulars that because of containing unchanged cottonseed oil the compounds are more rancidible than Kream Krisp are also substantially correct and borne out by the admissions of petitioner's witnesses as we have demonstrated in our

other briefs. Finally the statements of petitioner's circulars, thus supported by the record, show conclusively that the partially hydrogenized product is as a product different from and superior to the compounds.

Petitioner makes quotations (p. 9, *et seq.*) of statements by Mr. Gifford and others in the trial Court which it undertakes to say are inconsistent with the present position, but such is not the case. The plaintiff's counsel have continually endeavored to prevent the record rambling off into irrelevant chemistry, but nevertheless it is only necessary to read the testimony of defendant's expert Walker to see how far afield the discussion went. Plaintiff's view always has been and is now that an appreciation of the new fundamental principle of the patent that rancidibility can be reduced by producing a product in which compared with cottonseed oil the rancidible elements have been reduced relatively to the non-rancidible elements does not require any extensive excursion into the realm of chemistry.

The fact that the Patent Office issued a separate product patent No. 1,135,935 (R. 582) to Burchenal for Flake White on the same day as the patent in suit (though later as shown by the numbers of the patents and also of the applications) shows that the experts of the Patent Office regarded them as distinct products and throws upon petitioner a heavy burden of proof to establish the contrary. The Patent Office does not issue separate product patents where the only distinction is in the process.

Burchenal was the first one to conceive of or discover the applicability of any hydrogenized oil to the manufacture of any food product. Prior to his discovery the sole use conceived for it was in the manufacture of soap. Extended experiments under Burchenal's direction developed this new conception or discovery into the two

products, Flake White and Crisco. Unquestionably he was entitled to a patent or patents for both products. Petitioner's position amounts to the technicality of asserting that the Patent Office should have issued one patent covering both instead of two patents covering them separately. It makes no difference to any one which way it was done because both patents will expire on the same day and therefore the length of the monopoly is the same.

Petitioner's supplemental brief (p. 16) returns to the Kayser patents and the doings of Kayser, all of which has been disposed of in earlier briefs of respondent.

Petitioner (p. 17) criticises our statement that Jewel is a subject of Burchenal's companion patent. According to Mr. Richardson's testimony (R., p. 355) Jewel was made both ways, sometimes with animal stearin and at other times with the hydrogenated solid substituted for the animal stearin. As to the latter form, our statement was correct.

On page 18 petitioner admits that it does not rely upon Burchenal's companion patent for Flake White as part of the prior art but contends that nevertheless Flake White is to be considered a part of the prior art because in the course of Burchenal's invention he arrived at Flake White earlier than he did at Crisco. We do not understand the law, however, to be that a man's patent can be destroyed by what he did himself except in cases of abandonment. From the winter of 1908-1909 until the patents on both Flake White and Crisco were applied for, November 10, 1910, Burchenal was continually experimenting with the outcome that he invented both Flake White and Crisco. We do not understand that his Crisco patent can be any worse off because he also invented Flake White, and we know of no authority for holding that under these circumstances Flake White, whether as

a patent or as an experiment, can be set up as prior art to the detriment of the Crisco patent, particularly as they were both applied for and both issued on the same day, the Crisco patent in fact, according to the numbering, being ahead of the Flake White patent.

Petitioner refers (pp. 21-23) to the Sears' British patent 10783 of 1887 as describing an all vegetable artificial lard, but Sears does not state what kind of "vegetable fat" he proposed to add to the cottonseed oil, and of course it could not have been fat made by hydrogenizing cottonseed oil because in 1887, the date of the Sears patent, no way was known of hydrogenizing cottonseed oil or any other vegetable oil; the Normann patent with which the art of hydrogenizing started being dated as late as 1903 (R., p. 584). The Sears' compound therefore could not have been like Flake White.

Of course the Sears' compound is just as immaterial as Flake White and Jewel and all other compounds because of its content of unchanged cottonseed oil whatever the solid material may have been.

The only remaining topics not hereinbefore attended to which are discussed in Petitioner's supplemental brief (p. 25, *et seq.*) are the Moore patents (which can not be evidence for defendant of any facts) and the Halphen test. Both of these topics have been so fully discussed and disposed of in our previous briefs as to make repetition here unnecessary.

Respectfully submitted,

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